

### **REMARKS**

Applicants would like to thank the Examiner for the careful consideration given the present application and for the personal interview conducted on December 22, 2003, with applicant's representative. The application has been carefully reviewed in light of the Office action, and this response has been generated accordingly.

First, applicant notes that the Examiner again did not acknowledge the receipt of the priority documents in this Office action, despite that a prior Office action had done so. At the interview prior to this latest Office action, the Examiner stated that this was an oversight, and would be corrected, but it has not been corrected.

Claims 1 and 8-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carlson (U.S. 4,956,868). For the following reasons, the rejection is respectfully traversed.

Claim 1, as amended, recites a microphone encapsulated in an "electromagnetic shielding case", and an "analog/digital converter" which is "mounted on an outer surface of the electromagnetic shielding case". Claim 8 and new claim 13 recite similar limitations. Claim 9 recites "an analog/digital converter mounted in such a manner that it is electromagnetically shielded from said microphone".

Carlson does not teach an ADC. The Examiner states that it would be obvious to add an ADC. However, because Carlson appears to use all analog components, there would be no motivation for adding an ADC. Instead, such a modification would entirely change the principle of operation of the Carlson device (digital components and analog components are not typically interchangeable), and thus make it inoperable (MPEP §2143.01). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125. Accordingly, it is not proper to modify a reference to change the principle of operation, without some suggestion to do so. The Examiner has provided no such suggestion. Thus, claims 1, 8, 9, and 13 are patentable over the reference.

Further, because Carlson does not teach an ADC, it can certainly not teach an ADC that is mounted on an *outer surface* of the electromagnetic shielding case (claims 1, 8, and

13), or in such a manner to shield it from the microphone (claim 9). Thus, even if one would argue that a modification of Carlson to add an ADC were obvious, there is no suggestion that such an ADC be mounted as claimed, rather than in some other manner. Thus, claims 1, 8, 9, and 13 are patentable over the reference for this reason as well.

Claims 2-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carlson in view of Husung (U.S. Pat. No. 5,809,151). Claims 2-7 depend, directly or indirectly, on claim 1. Because Husung does not overcome the shortcomings of Carlson, these claims are patentable over the references.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32396.

Respectfully submitted,

PEARNE & GORDON, LLP

By: 

Robert F. Bodi, Reg. No. 48540

1801 East 9<sup>th</sup> Street  
Suite 1200  
Cleveland, Ohio 44114-3108  
(216) 579-1700

July 22, 2004